



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/681,954

10/08/2003

Ralph F. Kalies

036806.00431

7906

7590 09/09/2008
Louis C. Dujmich
Ostrolenk, Faber, Gerb & Soffen, LLP
1180 Avenue of the Americas
New York, NY 10036-8403

EXAMINER

REYES, REGINALD R

ART UNIT

PAPER NUMBER

3626

MAIL DATE

DELIVERY MODE

09/09/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/681,954	Applicant(s) KALIES, RALPH F.	
	Examiner REGINALD REYES	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7-22-2004/04-21-2004/12-24-2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. Claims 1-14 have been examined.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-10 are rejected under 35 U.S.C. 101 based on Supreme Court precedent and recent Federal Circuit decisions. Specifically claim 1 teaches a method dispensing generic pharmaceutical products. It is not tied to a machine or an apparatus. The Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); and *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 2 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

Art Unit: 3626

applicant regards as the invention. It is unclear as how the applicant can encrypt data before obtaining it.

4. Claims 10 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear as how the applicant can check the data before obtaining it.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Donoho et al U.S. 7,346,655.

6. With respect to claim 1, Donoho teaches a method for storing and reporting pharmacy data, comprising the steps of: a) selectively obtaining pharmacy data from at least one pharmacy (see for example Donoho column 53 lines 4-6); b) organizing and structuring the pharmacy data (see for example Donoho column 53 lines 14-17); c) storing the pharmacy data in a data repository (see for example Donoho column 53 lines 1-3); d) selectively allowing a requestor obtain at least a portion of the pharmacy data (see for example Donoho column 53 lines 1-3); e) formatting data requested by the requestor into a report (see for Donoho column 53 lines 5-6); and f) providing the report

Art Unit: 3626

to the requestor (see for example Donoho column 53 lines 5-6 and column 53 lines 17-20).

7. With respect to claim 2, Donoho teaches the method of claim 1 (as described above). Donoho teaches further comprising the steps of: a) encrypting the pharmacy data before obtaining it (see for example Donoho column 53 lines 55-58); and b) decrypting the pharmacy data after obtaining it (see for example Donoho column 53 lines 61-62).

8. With respect to claim 3, Donoho teaches the method of claim 1 (as described above). Donoho teaches wherein the pharmacy data are obtained by means of an electronic communications network (see for example Donoho column 57 lines 46-47).

9. With respect to claim 4 Donoho teaches the method of claim 3 (as described above). Donoho teaches wherein the requestor requests and receives a report by means of an electronic communications network (see for example Donoho column 14 lines 15-21 and Fig. 21).

10. With respect to claim 5, Donoho teaches the method of claim 4 (as described above). Donoho teaches wherein the electronic communications network is an intranet (see for example Donoho column 8 lines 2-9).

Art Unit: 3626

11. With respect to claim 6, Donoho teaches the method of claim 4 (as described above). Donoho teaches wherein the electronic communications network is the internet (see for example Donoho column 8 lines 2-9).

12. With respect to claim 7, Donoho teaches the method of claim 1 (as described above). Donoho teaches wherein the requester is selectively allowed access to a greater or lesser portion of the pharmacy data based upon predetermined criteria (see for example Donoho column 18 lines 23-39).

13. With respect to claim 8, Donoho teaches the method of claim 1 (as described above). Donoho teaches further comprising the step of checking the pharmacy data for defects before storing it (see for example Donoho column 42 lines 27-35).

14. With respect to claim 9, Donoho teaches the method of claim 1 (as described above). Donoho teaches further comprising the step of encrypting the report before sending it to the requestor (see for example Donoho column 19 lines 66-67 and column 20 lines 1-6).

15. With respect to claim 10, Donoho teaches the method of claim 1 (as described above). Donoho teaches further comprising the step of checking the pharmacy data before obtaining it (see for example Donoho column 93 lines 20-25).

Art Unit: 3626

16. With respect to claim 11 Donoho teaches a method for storing and reporting pharmacy data, comprising the steps of: a) selectively obtaining pharmacy data from at least one pharmacy by means of an electronic communications network (see for example Donoho column 53 lines 4-6 and column 57 lines 46-47); b) organizing and structuring the pharmacy data (see for example Donoho column 53 lines 14-17); c) storing the pharmacy data in a data repository (see for example Donoho column 53 lines 1-3); d) selectively allowing a requestor obtain at least a portion of the pharmacy data by means of the electronic communications network, wherein the requestor is selectively allowed access to a greater or lesser portion of the pharmacy data based upon predetermined criteria (see for example Donoho column 18 lines 23-39); e) formatting data requested by the requestor into a report (see for Donoho column 53 lines 5-6); and f) providing the report to the requestor (see for example Donoho column 53 lines 5-6 and column 53 lines 17-20).

17. With respect to claim 12, Donoho teaches the method of claim 11 (as described above). Donoho teaches further comprising the step of checking the pharmacy data before obtaining it (see for example Donoho column 93 lines 20-25).

18. With respect to claim 13, Donoho teaches the method of claim 11 (as described above). Donoho teaches wherein the electronic communications network is an intranet (see for example Donoho column 8 lines 2-9).

Art Unit: 3626

19. With respect to claim 14, Donoho teaches the method of claim 11 (as described above). Donoho teaches further comprising the steps of: a) encrypting the pharmacy data before obtaining it (see for example Donoho column 53 lines 55-58); and b) decrypting the pharmacy data after obtaining it (see for example Donoho column 53 lines 61-62).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent No. 7,401,027 teaches methods for collecting fees for healthcare management group.

U.S. Patent No. 7,398,217 teaches methods and systems for healthcare practice management.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to REGINALD REYES whose telephone number is (571)270-5212. The examiner can normally be reached on 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Gilligan can be reached on 571-272-6670. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3626

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. R./

Examiner, Art Unit 3626

/C Luke Gilligan/

Supervisory Patent Examiner, Art Unit 3626